

Appl. No. 10/700,131
Atty, Docket No. 9408
Reply dated February 13, 2006
Reply to Office Action of September 13, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1-11 are pending. Claims 12-14 are withdrawn. Claim 1 is amended, the basis of which is on page 5 of specification. Claim 8 is also amended to independent form including the limitations of the base claims. No new matter has been added.

Rejection Under 35 U.S.C. §102 Over U.S. 3,227,598

The Office Action rejects Claims 1, 3-5, and 7-8 under 35 U.S.C. §102(b) as being unpatentable over Robb (U.S. 3,227,598 – hereinafter “Robb”). Applicants respectfully traverse this rejection. To anticipate a claim, the cited reference must recite each and every element recited in a claim as arranged in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP §2131.

The Office Action states: “[Robb teaches] a three-dimensional product that contains raised projections that are connected by connecting elements that are recessed from and raised above the base of the product” (Office Action dated August 19, 2005, p. 2). The Office Action further notes that: “[Robb] is silent as to the height of the projections” (Office Action dated 09/13/2005, p. 3). As amended, applicant’s Claim 1 specifically limits the dimensions of applicant’s claimed invention in the z-direction to the range of about 300 μ m to 5,000 μ m. However, the core material taught in Robb would not be of the same dimensions claimed by applicant’s claim 1 because of the unique function that Robb’s teaching purports to perform. That is, the invention is Robb is directed toward the core material of building supplies such as “lightweight panels in interior and exterior walls, floors, decks, roofs, and other structural elements.” (Robb, col. 1, lines 15-16 et. seq.) Thus, the specific dimensions claimed by the applicant cannot be inherent in the teachings in Robb because such small dimensions would be unsuitable for the functions claimed by Robb. Because Robb does not recite each and every element recited in the rejected claims, Robb does not anticipate the claims. Accordingly, applicants respectfully request that the Examiner’s rejection to Claims 1, 3-5, and 7-8 under 35 U.S.C. §102(b) over Robb be withdrawn.

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Rejection Under 35 U.S.C. §102 Over U.S. 3,227,598

The Office Action rejects Claims 1, 3-5, and 7-8 under 35 U.S.C. §102(b) as being unpatentable over Hale (U.S. 3,525,663 – hereinafter “Hale”). Applicants respectfully traverse this rejection. To anticipate a claim, the cited reference must recite each and every element recited in a claim as arranged in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP §2131.

The Office Action states: “[Hale teaches] a three-dimensional product that contains raised projections that are connected by connecting elements that are recessed from and raised above the base of the product” (Office Action dated 09/13/2005, p. 2). The Office Action further notes that: “[Robb] is silent as to the height of the projections” (Office Action dated 09/13/2005, p. 3). As amended, applicant’s Claim 1 specifically limits the dimensions of applicant’s claimed invention in the z-direction to the range of about 300 μ m to 5,000 μ m. However, the core material taught in Hale would not be of the same dimensions claimed by applicant’s claim 1 because of the unique function that Hale’s teaching purports to perform. That is, the invention in Hale is directed toward the core material of for “structural core of high strength-to-weight characteristic,” “an anti-clastic membrane possessing superior acoustical properties,” and “stable structural insulation [panels]” among other things (Hale, col. 2, lines 21-52 et. seq.) Thus, the specific dimensions claimed by the applicant cannot be inherent in the teachings in Hale because such small dimensions would be unsuitable for the functions claimed by Hale. Because Hale does not recite each and every element recited in the rejected claims, Hale does not anticipate the claims. Accordingly, applicants respectfully request that the Examiner’s rejection to Claims 1, 3-5, and 7-8 under 35 U.S.C. §102(b) over Hale be withdrawn.

Rejection Under 35 U.S.C. §102 Over U.S. 4,555,433

The Office Action rejects Claims 1-8 under 35 U.S.C. §102(b) as being unpatentable over Jablonka (U.S. 4,555,433 – hereinafter “Jablonka”). Applicants respectfully traverse this rejection. To anticipate a claim, the cited reference must recite each and every element recited in a claim as arranged in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). “The identical invention must be

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shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); MPEP §2131.

The Office Action notes that: "[Jablonka] is silent as to the height of the projections. The examiner deems it inherent that these projections are at least 300 μm (.011 inches) in height since [Jablonka is] drawn to panel structures that would require a substantial thickness." (Office Action dated 09/13/2005, p. 4). As amended, applicant's Claim 1 specifically limits the dimensions of applicant's claimed invention in the z-direction to the range of about 300 μm to 5,000 μm . However, Jablonka would not be of the same dimensions claimed by applicant's Claim 1 because of the unique function that Jablonka teaching purports to perform. That is, the invention is Jablonka is directed toward "a sound-absorbing element ... which may extend over large areas of several square meters" (Jablonka, col. 4, lines 65-68, col. 5, line 1). Thus, the specific dimensions claimed by the applicant cannot be inherent in the teachings in Jablonka because such small dimensions would be unsuitable for the functions claimed by Jablonka. Because Jablonka does not recite each and every element recited in the rejected claims, Jablonka does not anticipate the claims.

In addition, the Office Action states that "Jablonka et al teaches three-dimensional products comprising raised protrusions 7 with connecting sections 6 that are recessed and raised above the base 5." (Office Action dated 09/13/2005, p. 3) However, Jablonka states that the purported connecting sections (6) are actually "crimp shaped recesses" (Jablonka, col. 5, line 24) and not actual connecting sections as claimed by the applicant. Thus, Jablonka does not teach every limitation claimed by the applicant. Accordingly, applicants respectfully request that the Examiner's rejection to Claims 1, 3-5, and 7-8 under 35 U.S.C. §102(b) over Jablonka be withdrawn.

Rejection Under 35 U.S.C. §103(a) Over Robb

Claims 1, 3-5, and 7-8 have been rejected under 35 U.S.C. 103(a) over Robb. Specifically, the Office Action states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references that the projection be at a height above that recited, motivated by the fact the references are drawn to panel structures that would require a substantial thickness." (Office Action dated 09/13/2005, p. 3) Applicants respectfully submit that the obviousness rejection is improper because the Office Action has not established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Office Action. Third, the prior art reference (or references, when combined) must teach or suggest all the claim limitations (MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1483 (Fed. Cir. 1991). In the present application, the Office Action's obviousness is improper because: In the present application, the Office Action's obviousness is improper because: (1) there is no suggestion or motivation to modify the references to arrive at the claimed invention; (2) there is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the references; and (3) the cited references to not teach or suggest all the claim limitations.

1. There is no suggestion or motivation to modify the cited references to arrive at the claimed invention

Obviousness can only be established by modifying reference teachings to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As amended, Claims 1, 3-5, and 7-8 describe an invention that has the dimensions in the z-direction of about 300-5,000 μm . Thus, in order for the claimed invention to be obvious in view of Robb, one would need some sort of teaching, suggestion, or motivation to modify the references in such a way as to limit the size of the invention in Robb. Robb teaches "lightweight panels in interior and exterior walls, floors, decks, roofs, and other structural elements." (Robb; col. 1, lines 15-16 et. seq.) However, the Robb reference has not provided any suggestion or motivation to modify the cited reference to arrive at the claimed invention and the obviousness rejection should be withdrawn.

2. There is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references

References may be modified to reject claims as *prima facie* obvious only if there is a reasonable expectation of success that the claimed invention will result. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present case, the

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Office Action has not established why one would have a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references. Thus, the obviousness rejection is improper and should be withdrawn.

As amended, Claims 1, 3-5, and 7-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . As discussed *supra*, Robb teaches a core material for “lightweight panels in interior and exterior walls, floors, decks, roofs, and other structural elements.” (Robb, col. 1, lines 15-16 et. seq.) The Office Action has not provided any evidence to show that the teachings in Robb – building materials and structural elements – can be functional at the size range as currently claimed by the applicant.

The cited reference does not recognize that a structure meant to be used as a core material in building materials and structural elements will achieve the invention in applicant’s Claims 1, 3-5, and 7-8, as amended. Therefore, there is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references and the obviousness rejection should be withdrawn.

3. The cited references to not teach or suggest all the claim limitations

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP §2143.03. As amended, Claims 1, 3-5, and 7-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . Thus, in order to establish a *prima facie* case of obviousness in the present case, the Office Action must establish that the cited references teach or suggest these claim limitations. This, the Office Action has not done.

The Office Action states that it would have been obvious to one of ordinary skill in the art to have a projection “at a height above that recited” (Office Action dated 09/13/2005, p. 3). As amended, Claims 1, 3-5, and 7-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . Because the cited reference does not teach applicant’s claimed dimensions, cited references do not teach, or suggest all, of the claim limitations. Accordingly, the obviousness rejection is improper and should be withdrawn.

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Rejection Under 35 U.S.C. §103(a) Over Hale

Claims 1, 3-5, and 7-8 have been rejected under 35 U.S.C. 103(a) over Hale. Specifically, the Office Action states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references that the projection be at a height above that recited, motivated by the fact the references are drawn to panel structures that would require a substantial thickness." (Office Action dated 09/13/2005, p. 3) Applicants respectfully submit that the obviousness rejection is improper because the Office Action has not established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Office Action. Third, the prior art reference (or references, when combined) must teach or suggest all the claim limitations (MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1483 (Fed. Cir. 1991). In the present application, the Office Action's obviousness is improper because: In the present application, the Office Action's obviousness is improper because: (1) there is no suggestion or motivation to modify the references to arrive at the claimed invention; (2) there is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the references; and (3) the cited references to not teach or suggest all the claim limitations.

1. There is no suggestion or motivation to modify the cited references to arrive at the claimed invention

Obviousness can only be established by modifying reference teachings to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As amended, Claims 1, 3-5, and 7-8 describe an invention that has the dimensions in the z-direction of about 300-5,000 μ m. Thus, in order for the claimed invention to be obvious in view of Hale, one would need some sort of teaching, suggestion, or motivation to modify the references in such a way as to limit the size of the invention in Hale. Hale

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is directed toward the core material of for "structural core of high strength-to-weight characteristic," "an anti-clastic membrane possessing superior acoustical properties," and "stable structural insulation [panels]" among other things (Hale, col. 2, lines 21-52 et. seq.) However, Hale has not provided any suggestion or motivation to modify the cited reference to arrive at the claimed invention and the obviousness rejection should be withdrawn.

2. There is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references

References may be modified to reject claims as *prima facie* obvious only if there is a reasonable expectation of success that the claimed invention will result. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the present case, the Office Action has not established why one would have a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references. Thus, the obviousness rejection is improper and should be withdrawn.

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The cited reference does not recognize that a structure meant to be used as a core material will achieve the invention in applicant's Claims 1, 3-5, and 7-8, as amended. Therefore, there is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references and the obviousness rejection should be withdrawn.

3. The cited references to not teach or suggest all the claim limitations

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP §2143.03. As amended, Claims 1, 3-5, and 7-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . Thus, in order to establish a *prima facie* case of obviousness in the present case, the Office Action must establish that

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As amended, Claims 1-8 describe an invention that has the dimensions in the z-direction of about 300-5,000 μm . Thus, in order for the claimed invention to be obvious in view of Jablonka, one would need some sort of teaching, suggestion, or motivation to modify the references in such a way as to limit the size of the invention in Jablonka. Jablonka teaches "a sound-absorbing element ... which may extend over large areas of several square meters" (Jablonka, col. 4, lines 65-68, col. 5, line 1). In addition, Jablonka teaches "crimp shaped recesses" (Jablonka, col. 5, lines 23-24) whereas the applicant claims "connecting elements." (Applicant's claim 1). However, Jablonka has not provided any suggestion or motivation to modify the cited reference to arrive at the claimed invention and the obviousness rejection should be withdrawn.

2. There is not a reasonable expectation of success of obtaining the claimed invention based upon the teachings of the cited references

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As amended, Claims 1-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . As discussed *supra*, Jablonka teaches "a sound-absorbing element ... which may extend over large areas of several square meters" (Jablonka, col. 4, lines 65-68, col. 5, line 1). In addition, Jablonka teaches "crimp shaped recesses" (Jablonka, col. 5, lines 23-24) whereas the applicant claims "connecting elements." (Applicant's claim 1). The Office Action has not provided any evidence to show that the teachings in Jablonka can be functional at the size range as currently claimed by the applicant.

The cited reference does not recognize that a structure meant to be used as a sound insulation material will achieve the invention in applicant's Claims 1, 3-5, and 7-8, as amended. Therefore, there is not a reasonable expectation of success of obtaining the

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claimed invention based upon the teachings of the cited references and the obviousness rejection should be withdrawn.

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To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); MPEP §2143.03. As amended, Claims 1, 3-5, and 7-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm . Thus, in order to establish a *prima facie* case of obviousness in the present case, the Office Action must establish that the cited references teach or suggest these claim limitations. This, the Office Action has not done.

The Office Action states that it would have been obvious to one of ordinary skill in the art to have a projection "at a height above that recited" (Office Action dated 09/13/2005, p. 3). As amended, Claims 1-8 describe an invention that has dimensions in the z-direction of about 300-5,000 μm with connecting elements between the raised protrusions. Because the cited reference does not teach applicant's claimed limitations, the cited references do not teach, or suggest all, of the claim limitations. Accordingly, the obviousness rejection is improper and should be withdrawn.

Allowable Subject Matter

The Examiner has indicated that claims 9-11 would be allowable if rewritten in independent form. Therefore, Applicants have amended claim 9, and respectfully request allowance of claims 9-11.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 103 and 35 USC 102(b). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention from the applied references. In view of the foregoing, reconsideration of this application, and allowance of Claims 1-11 is respectfully requested.

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Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By Betty J. Zea
Signature

Date: February 13, 2006
Customer No. 27752

B.J. Zea
Registration No. 36,069
(513) 634-5392

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